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HEWLETT-PACKARD COMPANY
Intellectual Property Administration
3404 E. Harmony Road
Mail Stop 35
FORT COLLINS, CO 80528

EXAMINER
CHEA, PHILIP J

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Please find below and/or attached an Office communication concerning this application or proceeding.

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JERRY.SHORMA@HP.COM
ipa.mail@hp.com
laura.m.clark@hp.com

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Application Number: 10/003,349
Filing Date: December 06, 2001
Appellant(s): KUNO ET AL.

Joseph G. Swan
Reg. No. 41,338
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 12/9/07 appealing from the Office action

mailed 7/3/06.

(1) Real Party in Interest

The examiner has no comment on the statement, or lack of statement, identifying by name the real party in interest in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The following is a list of claims that are rejected and pending in the application:

Claims 1-18 cancelled.

Claims 19-37 are rejected.

(4) Status of Amendments After Final

The examiner has no comment on the appellant's statement of the status of amendments after final rejection contained in the brief.

(5) Summary of Claimed Subject Matter

The examiner has no comment on the summary of claimed subject matter contained in the brief.

(6) Grounds of Rejection to be Reviewed on Appeal

The examiner has no comment on the appellant's statement of the grounds of rejection to be reviewed on appeal. Every ground of rejection set forth in the Office action from which the appeal is taken (as modified by any advisory actions) is being maintained by the examiner except for the grounds of rejection (if any) listed under the

subheading "WITHDRAWN REJECTIONS." New grounds of rejection (if any) are

provided under the subheading "NEW GROUNDS OF REJECTION."

NEW GROUND(S) OF REJECTION

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 19-24, 35, and 37 are rejected under 35 U.S.C. 101 because the claimed

invention is directed to non-statutory subject matter.

(7) Claims Appendix

The examiner has no comment on the copy of the appealed claims contained in

the Appendix to the appellant's brief.

(8) Evidence Relied Upon

6,226,675   Meltzer et al.

6,961,760   Li et al.

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

1.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

2.   Claims 19-37 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Meltzer et al. (US 6,226,675), herein referred to as Meltzer, and further in view of Li et

al. (US 6,961,760), herein referred to as Li.

As per claims 19,25, Meltzer discloses

[claim 25] a communications interface for exchanging documents with a Web

service and an external entity (see Fig. 11 [1101] and see column 77, lines 38-48);

a plurality of defined document type descriptions, each document type

description specifying a type of document that can be used (see column 18, lines 42-

55);

a set of defined interactions, each interaction specifying any expected inbound

document types and any resulting outbound document types (see column 21, lines 33-

40 and column 27, lines 18-49, where a participant specifies the compatible documents

which it is willing to transact with);

a set of transformations for use in connection with the defined interactions, each

transformation specifying how to convert one document type to another document type

(see column 21, lines 41-54, where translation occurs to make the document usable by

the destination), together with instructions for applying said transformations to

compensate for mismatches between documents actually received and expected

inbound document types (see column 22, lines 32-42); and

a transition structure that maps all permissible flows for a given conversation by identifying interactions from the set of defined interactions and specifying transitions between the identified interactions (see column 22, lines 43-51),

[claim 25] a control processor for exchanging documents with the Web service and with the external entity through the communications interface in accordance with the transition structure (see column 77, lines 38-48).

In considering wherein each limitation above is a separately defined component of said computer language, Meltzer does not expressly disclose that the specific steps above are a separately defined component. However, Meltzer discloses the limitations above are executed by processes and components that work together to achieve a successful conversation using documents (see column 78, line 44 – column 80, line 21 and Figs. 12,13, and 14, and 15). At the time of the invention it would have been obvious to one skilled in the art that the processes described by Meltzer can be separated and combined to produce any number of defined components and successfully achieve the result of a conversation using documents.

Although the system disclosed by Meltzer shows substantial features of the claimed invention (discussed above), it fails to disclose a common document structure.

Nonetheless, these features are well known in the art and would have been an obvious modification of the system disclosed by Meltzer, as evidenced by Li.

In an analogous art, Li discloses a system for transforming business messages to enable communication between parties in a distributed computing environment (see

Abstract). Li further shows that a common document structure is used to communicate

between the parties (see column 7, lines 31-67 to column 8, lines 1-26).

Given the teaching of Li, a person having ordinary skill in the art would have

readily recognized the desirability and advantages of modifying Meltzer by employing a

common document structure to communicate between parties, such as disclosed by Li,

in order to facilitate electronic communications with business partners by providing

services to define transformation logic.

As per claims 20,29 Meltzer in view of Li further disclose that at least one of the

specified interactions allows for any of a plurality of inbound document types, and

wherein the transition structure specifies different transitions depending upon which

document type is actually received (see Meltzer column 23, lines 38-60).

As per claims 21,32 Meltzer in view of Li further disclose that the plurality of

defined document type descriptions comprise XML stylesheets (see Meltzer column 23,

lines 38-60).

As per claims 22,33, Meltzer in view of Li further disclose that the defined

document type descriptions, the defined interactions and the set of transformations are

available for defining additional transition structures that specify interactions and

transitions for other desired conversations (see Meltzer column 23, lines 23-37).

As per claims 23,30, Meltzer in view of Li further disclose a second transition

structure, corresponding to a second conversation, that identifies a second group of

interactions from the set of defined interactions and specifies transitions between the

interactions in the second group (see Meltzer column 24, lines 31-57).

As per claims 24,31, Meltzer in view of Li further disclose that at least some of

the interactions in the second group also specify any applicable transformations (see

Meltzer column 24, lines 31-57).

As per claim 26, Meltzer in view of Li further disclose that at least some of the

interactions also specify any applicable transformations (see Meltzer column 21, lines

41-54).

As per claim 27, Meltzer in view of Li further disclose that both the transition

structure and a plurality of transition structures for other Web services are accessible

through a central Web-based registry (see Meltzer column 9, lines 35-44).

As per claim 28, Meltzer in view of Li further disclose that the transition structure

defines permissible conversation flows from the perspective of the Web service (see

Meltzer column 9, lines 35-44).

As per claim 34, Meltzer in view of Li further disclose that the control processor is

located remotely from a processor executing the Web service (see Meltzer Fig. 11,

where host services [1105] and [1106] are separated from document translator [1103]).

As per claims 35,36, Meltzer in view of Li further disclose that the common

document structure comprises an extensible markup language (XML) (see Li column 7,

lines 40-43).

As per claim 37, Meltzer in view of Li further disclose that the set of defined

interactions models states of the given conversation, the transition structures defines

flows between states of the given conversation, and each state is defined independently

of how the given conversation was navigated to reach each state (see column 78, lines

15-34, and 44-60, showing an example of a defined interaction for a purchase order).

NEW GROUND(S) OF REJECTION

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of
> matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the
> conditions and requirements of this title.

Claims 19-24, 35, and 37 are rejected under 35 U.S.C. 101 because the claimed

invention is directed to non-statutory subject matter. The claims are directed to a

computer-readable medium.

Claims 19-24, 35, and 37 are rejected under 35 U.S.C. 101 because the claimed

invention is directed to non-statutory subject matter. Claim 19 sets forth a "computer

readable medium." However, the specification as originally filed does not explicitly

define the computer readable medium. In fact, it is entirely silent as to any specific

embodiment of the claimed "computer readable medium". The United States Patent and

Trademark Office (USPTO) is obliged to give claims their broadest reasonable

interpretation consistent with the specification during proceedings before the USPTO.

See In re Zletz, 893 F.2d 319 (Fed. Cir. 1989) (during patent examination the pending

claims must be interpreted as broadly as their terms reasonably allow). The broadest

reasonable interpretation of a claim drawn to a computer readable medium (also called

machine readable medium and other such variations) typically covers forms of non-

transitory tangible media and transitory propagating signals *per se* in view of the

ordinary and customary meaning of computer readable media, particularly when the

specification is absent an explicit definition or is silent. *See* MPEP 2111.01. When the

broadest reasonable interpretation of a claim covers a signal *per se*, the claim must be

rejected under 35 U.S.C. § 101 as covering non-statutory subject matter. *See In re*

Nuijten, 500 F.3d 1346, 1356-57 (Fed. Cir. 2007) (transitory embodiments are not

directed to statutory subject matter) and *Interim Examination Instructions for Evaluating*

Subject Matter Eligibility Under 35 U.S.C. § 101, Aug. 24, 2009; p. 2.

(10) Response to Argument

A)   Appellant contends that Meltzer and Li does not disclose the document

type descriptions, set of interactions, set of transformations and transition structure as

separately defined components.

In considering A), the Examiner respectfully disagrees. The claims merely

require separately defined components. They do not require that each limitation is a

separately defined component that is encapsulated as its own software function and is

interoperable when being replaced with other encapsulated software functions when

changes need to be made as it is apparently alleged by the Appellant. The Examiner

believes that the Appellant is giving "separately defined component" too much meaning.

The Examiner is using the broadest reasonable interpretation when considering the

limitations as separately defined components. Meltzer does not use explicit language

that each of the limitations of the claims is a separately defined component. However,

Meltzer discloses in column 78, line 44 – column 80, line 21 that the invention is carried

out as separately defined processes, i.e. components of software run on a processor. It

would have been obvious to one of ordinary skill in the art to separate or combine any

number of these processes i.e. components, in order to achieve the function that is

desired of the program.

B)   Appellant contends that Meltzer does not disclose a set of defined

interactions that is separately defined from a plurality of document type descriptions, a

set of transformations and a transition structure.

In considering B), the Examiner respectfully disagrees. Meltzer shows

that document types are defined by a user and that input document types and outbound

document types are defined (see column 21, lines 33-40). A user is able to identify

itself, and identify the types of input documents and the types of output documents with

which it is willing to transact business. Meltzer disclose that the transformations are

defined in by a translator module (see column 21, lines 41-54). Finally Meltzer

discloses the transition structure as a schematic mapping to allow a conversation

between documents as defined by their languages, interface definitions, service

descriptions and the descriptions of input and output documents (see column 22, lines

43-51). In considering these interactions as separately defined, please see discussion

A) above.

C)   Appellant contends that Meltzer dose not say anything about transitions to

different interactions as per claims 20 and 29.

In considering C), the Examiner respectfully disagrees. The parser identifies the document type and according to the definition the document is parsed and translated into the necessary format (see column 23, lines 38-60). A different definition would cause the parser to parse differently and translate differently.

D)   Appellant contends that Meltzer does not disclose the limitations of claims 23 and 30.

In considering D), the Examiner respectfully disagrees. The diverse and flexible implementations of transaction processing indicates that additional transition structures and be provided for other desired conversations (see column 23, lines 23-37).

E)   Appellant contends that Meltzer does not disclose the limitations of claims 24 and 31.

In considering E), the Examiner respectfully disagrees. Meltzer discloses that the listener process the events to ensure that the elements carry data that matches the schematic mapping for the element and react according to the process needed at the receiving node, thereby transforming a document into another document by parsing out only the needed tags.

F)   Appellant contends that Meltzer does not disclose the limitations of clam 26.

In considering F), the Examiner respectfully disagrees. The claim merely requires that some of the interactions specify any applicable transformations. Meltzer discloses many transformations through out its text and specifically at column 21, lines 41-54, where translating from one format into another is considered a transformation.

G)   Appellant contends that Meltzer does not disclose the limitations of claim 27.

In considering G), the Examiner respectfully disagrees. Meltzer discloses a central web-based registry in the form of allowing a user to register supported document types that aid in the conversation between two disparate business entities.

H)   Appellant contends that Meltzer does not disclose the limitations of claim 28.

In considering H), the Examiner respectfully disagrees. In column 9, lines 35-44, those supported document types are the documents that are allowed to be processed during the conversation between two business entities. Therefore, they are transition structures that define what documents are used for a conversation.

I)   Appellant contends that Meltzer does not disclose the limitations of claim 34.

The Examiner respectfully disagrees. The word separated has a very broad meaning. The separation can be on the same machine as two separate

processes, or be on two different machines. Using the broadest reasonable

interpretation, the Examiner believes that Fig. 11, shows that the control processor

[1103] is separate from the web service [1105 and 1106].

J)   Appellant contends that Meltzer does not disclose the limitations of claim

37.

The Examiner respectfully disagrees. Meltzer discloses defined

interactions that are supposed to take place according to a set of defined translations

structures and flows by having a very specific state to follow once being executed (see

column 78, lines 15-34 and 44-60).

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the

Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

This examiner's answer contains a new ground of rejection set forth in section **(9)**

above. Accordingly, appellant must within **TWO MONTHS** from the date of this answer

exercise one of the following two options to avoid *sua sponte* **dismissal of the appeal**

as to the claims subject to the new ground of rejection:

(1) **Reopen prosecution.** Request that prosecution be reopened before the

primary examiner by filing a reply under 37 CFR 1.111 with or without amendment,

affidavit or other evidence. Any amendment, affidavit or other evidence must be

relevant to the new grounds of rejection. A request that complies with 37 CFR

41.39(b)(1) will be entered and considered. Any request that prosecution be reopened

will be treated as a request to withdraw the appeal.

(2) **Maintain appeal.** Request that the appeal be maintained by filing a reply

brief as set forth in 37 CFR 41.41. Such a reply brief must address each new ground of

rejection as set forth in 37 CFR 41.37(c)(1)(vii) and should be in compliance with the

other requirements of 37 CFR 41.37(c). If a reply brief filed pursuant to 37 CFR

41.39(b)(2) is accompanied by any amendment, affidavit or other evidence, it shall be

treated as a request that prosecution be reopened before the primary examiner under

37 CFR 41.39(b)(1).

Extensions of time under 37 CFR 1.136(a) are not applicable to the TWO

MONTH time period set forth above. See 37 CFR 1.136(b) for extensions of time to

reply for patent applications and 37 CFR 1.550(c) for extensions of time to reply for ex

parte reexamination proceedings.

Respectfully submitted,

/Philip J Chea/

Primary Examiner, Art Unit 2453

A Technology Center Director or designee must personally approve the

new ground(s) of rejection set forth in section (9) above by signing below:

/N. Le/

Director, Technology Center 2400

Conferees:

/Liangche A. Wang/

Primary Examiner, Art Unit 2453

/JOSEPH THOMAS/

Supervisory Patent Examiner, Art Unit 2453